STW

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Atty. Docket No.: 003797.84618

John L. Beezer et al.

Serial No.: 09/455,807 | Group Art Unit: 2174

Filed: 12/7/1999 Examiner: Steven Sax

For: Method and Apparatus for Capturing and Rendering Text Annotations for Non-Modifiable Electronic Confirmation No.: 5593

Content

## **INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(c)**

U.S. Patent and Trademark Office Customer Service Window, Mail Stop Amendment Randolph Building 401 Dulany Street Alexandria, VA 22314

Sir:

In accordance with Applicants' duty of disclosure, the following information is submitted for consideration by the United States Patent and Trademark Office in connection with the above-captioned application. The information is identified on the attached PTO 1449 form.

In accordance with the rules of practice under 37 C.F.R. § 1.98, including the waiver of October 19, 2004, Applicants are only providing photocopies of non-US patent and literature documents.

One of the following certification statements under 37 C.F.R. § 1.97(e) applies to each of the references cited herein:

The undersigned certifies under 37 C.F.R. § 1.97(e)(1) that some of the references cited herein were cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement. Also enclosed is a copy of the search report for a corresponding foreign application indicating the relevance of the references cited therein.

The undersigned certifies under 37 C.F.R. § 1.97(e)(2) that no item of information contained in the information disclosure statement [that is not a part of the certification under 37 C.F.R. § 1.97(e)(1) above] was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure

statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement. Some of the cited references were cited in related U.S. applications.

Applicants do not waive any right to take appropriate action to establish patentability over the listed documents should they be applied as references against the claims of the present application.

It is respectfully requested that the Examiner fully consider each of the documents, initial the enclosed Form PTO-1449 in the appropriate place to indicate that the document has been considered, and return a copy of the initialed form to the undersigned in accordance with MPEP Section 609.

Applicants believe that no fee is necessary pursuant to 37 C.F.R. § 1.97(c). However, if a fee is due, the Office is authorized to charge Deposit Account No. 19-0733.

Respectfully submitted,

Date: February 11, 2005

Lew D. Fedorochko
Reg. No. 35,509

Banner & Witcoff, Ltd. 1001 G Street, N.W. Washington, D. C. 20001-4597 (202) 508-9100

GDF:lab

Please type a plus sign (+) inside this box

of 1

Sheet

PTO/SB/08A (08-00)

Approved for use through 10/31/2002. OMB 05517-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE required to respond to a collection of information unless it contains a valid OMB control number.

Under the Paperwork Reduction

Substitute for form 1449A/PTO Complete if Known 09/455,807 **Application Number INFORMATION DISCLOSURE** 12/7/1999 Filing Date STATEMENT BY APPLICANT John L. Beezer et al. First Named Inventor 2174 Group Art Unit (use as many sheets as necessary) **Examiner Name** Steven Sax 003797.84618

Attorney Docket Number

Examiner Initials *	Cite No.1	U.S. Patent Document	Name of Patentee or Applicant	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevan Figures Appear
		Number Kind Code <sup>2</sup> known)	(if of Cited Document		
		5,826,025	Gramlich	10/1998	
		5,982,370	Kamper	11/9/99	
		6,714,214	DeMello	3/2004	
		5,761,485	Munyan	6/1998	
-					

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No.1	Foreign Patent Document			Name of Patentee of		Pages, Columns, Lines, Where Relevant	
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> ( known)	Applicant of Cited Document	Cited Document MM-DD-YYYY	Passages or Relevant Figures Appear	T <sub>6</sub>
		EP	034283	38 A	IBM	11/23/89		Х
			·- ·· · · -					

Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T²
	•	Marshall, C., "Annotation from paper books to the digital library," ACM	
		International Conf. on Digital Libraries, 1997, pp. 131-140	
		"Joke eBook," 7/1998, PrimaSoft PC, Inc., Electronic Book Series	
		Version 1.0, pp. 1-5	
		Munyan, D., "Everybook, Inc: Developing the E-Book in Relation to	
		Publishing Standards," 09/1998,	
		http://www.futureprint.kent.edu/articles/munyan01.htm, pp. 1-7	

Examiner Signature	Date Considered	